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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte MICHAEL P. DELANEY

Appeal No. 2004-2270  
Application 09/383,691<sup>1</sup>

ON BRIEF

Before JERRY SMITH, BARRETT, and GROSS, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-11, 13, 16-22, and 26-35.

Claims 12, 14, 15, and 23-25 are objected to.

We reverse.

<sup>1</sup> Application for patent filed August 26, 1999, entitled "Publication of an Attorney-Client Warning Message."

### BACKGROUND

The invention relates to a data processing method, system, and computer program product for determining whether a data object contains a privileged communication (PCOM) between an attorney and a client of the attorney (or between any two persons) and, if so, displaying a PCOM message.

Claim 1 is reproduced below.

1. A data processing method, comprising the steps of:

providing a server, a data object coupled to the server, and a node coupled to the server;

sending a request from the node to the server for access of the data object by the node,

checking for whether the requested access is security blocked;

if the requested access is not security blocked, determining whether the data object includes a privileged communication (PCOM) between an attorney and a client of the attorney;

if the data object includes the PCOM, deciding whether a PCOM message for the data object is to be published at the node; and

if the PCOM message is to be published, publishing the PCOM message at the node.

### THE REFERENCES

The examiner relies on the following references:

Keithley et al. (Keithley)	5,584,025	December 10, 1996
Theimer et al. (Theimer)	5,649,099	July 15, 1997
Rackman	5,903,646	May 11, 1999

THE REJECTIONS

We refer to the final rejection (Paper No. 7) (pages referred to as "FR\_\_") and the examiner's answer (Paper No. 10) (pages referred to as "EA\_\_") for a statement of the examiner's rejection, and to the brief (Paper No. 9) (pages referred to as "Br\_\_") and reply brief (Paper No. 11) (pages referred to as "RBr\_\_") for a statement of appellant's arguments thereagainst.

Claims 1-10, 13, 16-21, and 26-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer and Rackman. The examiner's statement of the claims rejected is modified to reflect the fact that the rejection of claims 14, 15, 24, and 25 has been withdrawn (EA10), and we assume that the status of these claims is that they stand objected to. We note that the rejection of claim 26 should also be withdrawn since it depends on claim 24 whose rejection is withdrawn.

Claims 11 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer and Rackman, further in view of Keithley.

OPINION

Grouping of claims

Appellant groups the claims as follows, where the claims in each group stand or fall together:

- Group 1: claims 1, 3, 16, and 29;
- Group 2: claims 31 and 33-35;
- Group 3: claims 2, 17, 30, and 32;
- Group 4: claims 11 and 22;
- Group 5:<sup>2</sup> claims 3-5, 10, and 21;
- Group 6: claims 6-9, 13, 18-20, 24, 27 and 28.

Nevertheless, the brief addresses the merits of all claims except claim 3, which relies on the dependency from claim 2. Since the claims are argued individually, the grouping of claims to stand or fall together has no meaning. This confusion about what is meant by grouping was one reason the grouping requirement was removed from the new rules in 37 CFR § 41.37 (2004).

We agree that independent claims 1, 16, and 29 are logically grouped to stand or fall together because they contain similar limitations. Claim 1 is taken as representative of this group and appellant has pointed out that claims 16 and 29 contain similar limitations to those argued (RBr2; RBr4). Independent claim 31 is similar to the other independent claims but has a broader definition of the privileged communication (PCOM) and is discussed separately. Lastly, we discuss claims 11 and 22 which rely on the reference to Keithley.

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<sup>2</sup> The rejection of claims 14, 15, 25, and 26 has been withdrawn (EA10). Appellant groups claim 3 in two groups.

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Claims 1-10, 13, 16-21, 26-30

The examiner finds that Theimer discloses a method for delegating server access rights to a resource, but "Theimer does not disclose that the resource (data object) includes attorney and client communications" (FR3). The examiner finds that Rackman teaches that "documents stored on the data base contain confidentiality fields that control access to the specified documents to the attorney's [sic] associated with the documents (privileged communication between attorney-client)" (FR3) and concludes that it would have been obvious "for the permission bits in Theimer to include an [sic] confidentiality field identifying that the file contains attorney client communications in order to provide a system for the distribution of confidential documents for attorney's [sic] as taught by Rackman" (FR3).

Appellant presents three reasons why the rejection must fail. First, it is argued (Br7) that neither Theimer nor Rackman teach or suggest the feature: "if the requested access is not security blocked, determining whether the data object includes a privileged communication (PCOM) between an attorney and a client of the attorney." It is noted that the examiner admits that Theimer does not disclose anything about a PCOM between an attorney and a client (Br7). Appellant argues that bits CF1 and CF2, relied on by the examiner, denote a level of confidentiality

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associated with a document, which is not indicative of whether a document is a PCOM (Br7-8).

The examiner finds the arguments unpersuasive because (EA6):

Rackman discloses that the litigation documents in question are stamped with "Bates number" identifications which identify redacted portions of the documents as being irrelevant or privileged based on the grounds of attorney client privilege (Col. 1, lines 14-22), which is interpreted to indicate attorney client communication or PCOM. These "Bates number" identifications and subsequent redacted portions of the documents can indicate whether the portion in question is confidential or not (Col. 9, lines 51-62). These litigation documents may contain not only subject matter of a particular lawsuit, but also unrelated matters (Col. 1, lines 65-67). So it is desirable to redact portions of these documents that are considered privileged (Col. 2, lines 3-8).

Appellant responds that the Bates number stamp does not determine whether the Bates-stamped document includes a privileged communication (PCOM) between an attorney and a client, but, as stated at column 1, lines 14-22, the Bates stamp only indicates that content within the document is redacted because of irrelevancy, attorney-client privilege, or work product immunity (RBr3). It is argued that since attorney-client privilege is only one reason out of three possible reasons for the redacted content, it is impossible to determine from the presence of a Bates stamp that the document includes a PCOM (RBr3). Appellant notes that Rackman discloses "privileged logs (lists of documents which are being withheld on the grounds of attorney-client privilege or work product immunity)" (col. 1, lines 20-22), but the documents could be withheld for either reason (RBr3-4).

Initially, we note that the "Bates number" is merely an identification number stamped on the page, usually a page number, which is named "after the machine which is often used to stamp the number on the page" (col. 5, lines 16-17). The Bates machine is often a handheld device that changes the number after every time it stamped. The Bates number has nothing to do with indicating that a document has been redacted or why it is redacted. Nevertheless, Rackman discloses that field 4 in Fig. 3 is a "redaction reason" field. Rackman discloses that matter may be redacted because it is irrelevant or privileged (col. 1, line 18; col. 2, lines 2-3) and one of these reasons may be written into the field (col. 6, lines 42-55). Redaction and confidentiality are two separate document restrictions (col. 1, lines 62-63; col. 2, lines 22-23); note the separate RE (redaction exists) flag and the two levels of confidentiality flags CF1 (first level confidentiality) and CF2 (second level confidentiality) (Fig. 5; col. 7, lines 32-52). The confidentiality flags deal with levels of access to the documents and are not related to the question of privilege between an attorney and client; for this reason, the examiner's reliance on the confidentiality bits is misplaced and the reasoning in the final rejection is not persuasive. While Rackman does provide some way of identifying documents as containing privileged material, there are several different kinds of privilege, e.g.,

attorney-client privilege to prevent disclosure of confidential communications and the work-product privilege (or rule) which provides a qualified immunity of an attorney's work from discovery (primarily established to protect an attorney's litigation strategy). We assume that it would be possible to search the words in the redaction fields to determine which redactions are because of a PCOM, but this is not taught by Rackman. Access to documents in Rackman is based on the confidentiality level and whether the user has permission to see the redacted documents. An accessed document may passively have a redaction reason associated with it, but there is no "determining whether the data object includes a privileged communication (PCOM) between an attorney and a client of the attorney." The page displayed in Fig. 1 contains no indication of a privileged communication: the "Bates" number R 007612 is merely a page number, and the word "CONFIDENTIAL" indicates a level of confidentiality, not that there is a privilege associated with the redacted portion. Thus, the combination of Theimer and Rackman fail to disclose or suggest "determining whether the data object includes a privileged communication (PCOM) between an attorney and a client of the attorney."

Second, appellant argues (Br8) that neither Theimer nor Rackman teach or suggest the feature: "if the data object includes the PCOM, deciding whether a PCOM message for the data



object is to be published at the node; and if the PCOM message is to be published, publishing the PCOM message at the node." It is argued that Rackman does not teach any indication that a document is a PCOM and, consequently, Rackman does not teach whether to publish a PCOM message and does not publish a PCOM message (Br8).

The examiner disagrees and states (EA6):

Rackman discloses in Fig. 1 that a redacted document displays a confidentiality message (8b) when a portion of the document has been redacted. If we examine the figure further we see that redacted portion 8a is shown without a confidentiality message, while 8b contains both the confidentiality message along with its associated "Bates number" (Col. 5, lines 5-27). This would indicate that a decision is made to publish a message and "Bates number" at one portion of a document and not another.

Appellant replies that "CONFIDENTIAL" as displayed in reference numeral 8b in Fig. 2 does not imply a PCOM between an attorney and a client of the attorney, since the reason for the "CONFIDENTIAL" could be work-product immunity (RBr5). It is argued that the examiner's statement that "[the CONFIDENTIAL symbol] would indicate that a decision is made to publish a message and 'Bates number' at one portion of a document and not another" is without support (RBr5). It is also argued that Fig. 1 in Rackman is only a page on an optical disk and the examiner "has not cited anything in Rackman disclosing publishing the PCOM at a node" (RBr5).

The only thing that will be published in Rackman is the document shown in Fig. 1, where a redaction is shown by region 8a

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which has been made all white or all black (col. 5, line 9) and the region 8a contains two pieces of information, an identification number ("Bates number") and a legend, such as "CONFIDENTIAL" (col. 5, lines 13-24), neither of which indicate the reason for the redaction or that the reason for the redaction is a PCOM. While the redaction reason contained in field 4 can be because the material is irrelevant, or attorney-client privilege, or work-product privilege, there is no teaching or suggestion in Rackman of determining that the redaction is due to a PCOM and then publishing a PCOM message. The user would presumably have access to the redacted document regardless of any privilege notations and would not receive a message about privileges. Thus, the combination of Theimer and Rackman fails to disclose or suggest the limitation "if the data object includes the PCOM, deciding whether a PCOM message for the data object is to be published at the node; and if the PCOM message is to be published, publishing the PCOM message at the node."

Third, appellant argues that the examiner's argument for modifying Theimer with Rackman's disclosure of access control to litigation documents is not persuasive (Br8). It is argued that Theimer is concerned with the controlled delegation of access rights from clients to trusted intermediaries (abstract) and accomplishes this with access control programs (ACPs). It is argued that Rackman does not disclose anything that could be used

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to improve Theimer's invention inasmuch as the ACPs do everything that needs to be done to accomplish the objective of Theimer's invention (Br9). Furthermore, it is argued, Theimer has no disclosed need for access control to litigation documents, and no need specifically for publishing a PCOM message (Br9).

The examiner responds that it would have been obvious to include the confidentiality permission bits in Rackman with the access rights of Theimer so that the user, including attorneys, may distribute confidential documents and expands the user realm to include attorneys (EA6-7).

Appellant replies that the examiner has not cited any suggestion or incentive in the prior art (RBr7-8).

Even if it there were motivation to modify Theimer in view of Rackman, the combination would not suggest the claimed invention for the first two reasons discussed above. As previously discussed, the confidentiality flags in Rackman deal with levels of access to the documents and are not related to the question of privilege between an attorney and client. It is not necessary to decide the motivation issue.

For the reasons stated above, the rejection of independent claim 1 and dependent claims 2-10 is reversed. As pointed out by appellant, independent claims 16 and 29 contain limitations corresponding to the two limitations discussed in claim 1 (see

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RBr2; RBr4) and the rejection of these claims and their dependent claims 17-21, 26-28, and 30 is reversed.

Claims 31-35

Independent claim 31 does not contain any limitation relating to a PCOM between an attorney and a client of the attorney. Claim 31 recites "status means for making a determination as to whether the data object includes a PCOM between a first person and a second person."

The examiner relies on the same reasoning as for claim 1.

Appellant presents two reasons why Theimer in view of Rackman does not teach every feature of claim 31. First, it is argued that neither Theimer nor Rackman teach or suggest the feature: "publication means for publishing the PCOM message for the data object; and decision means for deciding whether to execute the publication means to publish the PCOM message for the data object, wherein the decision means includes a dependence on the determination made by the status means." It is argued that Rackman does not disclose means for publishing a PCOM message and does not publish a PCOM message, where a PCOM message relates to a message indicating that the communication is a privileged communication (Br30). It is argued that "the references of Theimer in view of Rackman cited by the Examiner allegedly disclose a PCOM only between an attorney and a client of the attorney, and do not disclose a PCOM between any two other

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classes of persons or parties" (RBr23). Appellant relies on the arguments presented for claim 16.

The examiner is silent regarding claim 31 and apparently relies on previous arguments.

Claim 31 contains similar limitations to claim 1 except for the broader nature of the PCOM. Claim 31 recites "making a determination as to whether the data object includes a PCOM between a first person and a second person," whereas claim 1 recites "determining whether the data object includes a privileged communication (PCOM) between an attorney and a client of the attorney." Claim 31 recites "deciding whether to execute the publication means to publish the PCOM message," whereas claim 1 recites "deciding whether a PCOM message for the data object is to be published." For the reasons discussed in connection with claim 1, we find that Rackman does not teach or suggest these limitations. We dismiss appellant's argument that even if Rackman discloses a PCOM between an attorney and a client of the attorney, it does not disclose a PCOM between any other two classes of persons: a PCOM between an attorney and client would meet the limitation of a PCOM between a first person and a second person.

Second, it is argued that the examiner's argument for modifying Theimer with Rackman's disclosure of access control to litigation documents is not persuasive (RBr30-31).

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It is not necessary to discuss the issue of motivation since we find that the combination of Theimer and Rackman does not teach or suggest every limitation of claim 31.

For the reasons stated above, the rejection of claim 31 and its dependent claims 32-35 is reversed.

Claims 11 and 22

The rejection of claims 11 and 22 further relies on Keithley. We find that Keithley does not cure the deficiencies of Theimer and Rackman with regard to detecting and publishing a PCOM in claims 1 and 16. Accordingly, the rejection of claims 11 and 22 is reversed.

## CONCLUSION

The rejections of claims 1-11, 13, 16-22, and 26-35 are reversed.

REVERSED

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Administrative Patent Judge

Lee E. Barrett

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